

**REMARKS/ARGUMENTS**

Applicant thanks the Examiner for the thorough consideration given the present application. Claims 1-8, 10-12, 14-22, 24-26, 28-58, and 65-81 are pending in the present application.

Claims 9, 13, 23, 27, and 59-64 have been cancelled.

Claims 65-81 are new.

Claims 1, 10, 12, 14, 15, 17-19, 24, 26, 28, 29, 31, 32, 35, 36, 38-46, 49, 55, and 57 have been amended.

Claims 1, 10, 12, 19, 24, 26, 31, 32, 40, 41, 46, 49, 55, 65, 66, 69, 70, 75, 76, 78, and 79 are independent claims.

The Examiner is respectfully requested to reconsider his rejections in view of the Amendments and Remarks as set forth hereinbelow.

**Allowable Subject Matter**

Applicant gratefully acknowledges the Examiner's indication that claims 46-48 are allowed.

It is also gratefully acknowledged that the Examiner considers the subject matter of claims 13-18, 26-29, 35-37, 39, and 54 as being allowable if rewritten in independent form.

Although not conceding the appropriateness of the Examiner's rejections, the following amendments have been made to secure allowance of various claims.

Claim 26 has been rewritten in independent form. Further, independent claim 1 has been rewritten to include the allowable subject matter of claim 13. Similarly, independent claim 19 has been rewritten to include the allowable subject matter of claim 27.

Applicant respectfully submits that originally filed claim 12 recites features similar to originally filed claim 13. In the above amendments, Claim 12 has been rewritten in independent form including the subject matter of originally filed claims 1 and 9. Thus, Applicant submits that claim 12 now incorporates allowable subject matter.

Furthermore, independent claim 49 has been amended to include the features of claim 13. Thus, Applicant respectfully submits that claim 49 is now allowable for reasons similar to amended claim 1. Also, independent claim 55 has been amended to incorporate the features of claim 27. Thus, Applicant respectfully submits that claim 55 is now allowable for reasons similar to amended claim 19.

Accordingly, it is respectfully submitted that independent claims 1, 12, 19, 26, 49, and 55 are now in condition for

allowance. Further, it is respectfully submitted that claims 2-8, 14-18, 20-22, 28-30, 50-54, and 56-58 are now allowable at least by virtue of their dependency on allowable claims 1, 19, 49, and 55.

#### **Claim for Priority**

It is gratefully acknowledged that the Examiner has recognized the Applicant's claim for foreign priority. In view of the fact that the Applicant's claim for foreign priority has been perfected, no additional action is required from the Applicants at this time.

#### **Drawings**

It is gratefully acknowledged that the Official Draftsperson has approved the Formal Drawings submitted by the Applicants. The drawings comply with the requirements of the USPTO. No further action is necessary.

#### **Acknowledgment of Information Disclosure Statement**

The Examiner has acknowledged the Information Disclosure Statements filed, respectively, on September 15, 1999 and March 3, 2003. Initialed copies of the PTO-1449s have been received from the Examiner. No further action is necessary at this time

with regards to the abovementioned Information Disclosure Statements.

**Rejection Under 35 U.S.C. § 112**

Claims 8, 12 and 43 stand rejected under 35 USC § 112, second paragraph, as being indefinite. This rejection is respectfully traversed.

Initially, as discussed above, claim 12 has been rewritten in independent form including the subject matter of originally filed claims 1 and 9. Since the § 112 rejection of claim 12 was based on its dependency on claim 8, Applicant respectfully submits that this rejection is now moot with respect to claim 12.

As to claim 8, the Examiner alleges that the phrase "optically exposed and printed" is confusing. Applicant wishes to direct the Examiner's attention to the specification at page 72, line 24 - page 73, line 12. Applicant respectfully submits that this portion of the specification describes supplementary information being optically exposed and printed. Applicant further respectfully submits that one of ordinary skill in reading the claims in light of the specification would understand how supplementary information is optically exposed

and printed. Accordingly, reconsideration and withdrawal of this rejection as to claim 8 is respectfully requested.

As to claim 43, the Examiner asserts that the alternative language "...the camera and/or a supplementary recording means..." on lines 9-10 is indefinite. Accordingly, Applicant has amended claim 43 to replace this phrase with "at least one of the camera and a supplementary recording means." Applicant respectfully submits that this amendment is not a concession as to the appropriateness of the rejection, and that the amendment does not narrow or change the scope of the claim. In view of the amendment and arguments above taken alone or in combination, withdrawal of the rejection is respectfully requested.

#### **Prior Art Rejections**

##### **I. Claims 1-7, 9-11, 19-25, 30, 49-53, and 55-58.**

Claims 1-7, 9, 19-23, 30, 49-52, and 55-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's alleged admitted prior art (hereinafter "admitted prior art") in view of U.S. Patent No. 5,467,168 to Kinjo et al. (hereinafter "Kinjo") and U.A. Patent No. 5,689,326 to Yamada et al. (hereinafter "Yamada").

Applicant respectfully submits that in view of the above amendments, claims 1-7, 19-22, 49-53, and 55-58 are now in

condition for allowance for the reasons set forth above in the "Allowable Subject Matter" section. Furthermore, Applicant submits that claim 9 has been cancelled. Accordingly, the prior art rejections of claims 1-7, 9, 19-22, 49-53 and 55-58 have been rendered moot.

Claims 10, 11, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art in view of Kinjo and Yamada, and further in view of allegedly well-known prior art. This rejection is respectfully traversed.

#### Admitted Conventional Art

The admitted prior art discloses a process for acquiring digital image data and image input means, a process of image processing and image processing means, and a process for outputting a visible image and image output means, which are similar to those recited in the preambles of claims 1 and 19 of the present application. The admitted conventional art also discloses that the digital image data is an image data readout of a photographic film or an image data of the photographed image obtained directly from a digital camera.

Kinjo

Kinjo relates, not to digital photographic printers, but to analog photographic printers for directly printing an image photographed on a photographic film on photographic printing paper. Kinjo discloses that photographing information representing the photographic conditions at the time of photographing each image is recorded in a recording portion of an image photographed on a film by a camera, and read out of the recording portion. Then, on the basis of the readout photographing information, Kinjo discloses that images photographed under equal or similar photographing conditions are printed under equal or similar printing conditions. Further, Kinjo discloses that the photographing information may include at least one of: photographing time, the luminance value for determining an exposure, magnification, distance to the subject, subject-in-focus position, stop, shutter speed, and use of stroboscopic light and the like.

While Kinjo describes that the photographic information is used to determine whether or not the photographic conditions of the photographed images are similar to each other, Kinjo does not capture supplementary information to be added to a visible image reproduced from the photographic information.

Yamada

Yamada discloses that when printing is performed directly from a photographic film onto a photo-sensitive material in analog photographic printing, supplementary information is printed within a preset region of a print region. In Yamada, the supplementary information may consist of: letters, symbols or figures; a combination thereof; or a combination of any of letters, symbols or letters with colors. In particular, Yamada discloses that supplementary information may include photographing date and time, photographing places, information regarding exposure during photographing, figures of red sun and the like. Yamada also discloses that the following information, which is written into the magnetic record 2a of the film 2, may be used as supplementary information: the type of camera used; the type of lens used; frame numbers; film sensitivity; time and date of photographing; designation of false zoom/panorama, rear light/under- or over-exposure photographing; whether or not flash photography is used; flash color temperatures; shutter speeds; diaphragm; subject distances; camera angles at the time of photography; sites of photography; subject titles such as "snow-covered mountain," "setting sun" or "people"; and photographic memos.



Accordingly, Yamada's disclosed supplementary information is information written in the magnetic record 2a of the film 2 and relating to photographing. In other words, Yamada uses photographing information as supplementary information, rather than capturing supplementary information related to the photographing information.

Claims 10, 11, 24, and 25 Not Obvious

In the above amendments, claims 10 and 24 have been rewritten to independent form including the subject matter of their respective base claims (as originally filed). Thus, Applicants respectfully submits that the above amendments have not changed the scope of claims 10 and 24.

In relation to independent claims 10 and 24, the Examiner asserts that "using photographic date and time data as a searching basis for photographic or supplementary information... is well known in the art," and that it would have been obvious to one of ordinary skill in the art to provide such a search feature in the combination of the admitted prior art, Kinjo, and Yamada (see Office Action at page 8, last two paragraphs). Applicant respectfully disagrees.

M.P.E.P. § 2141.02 sets forth the following requirements for a proper rejection under 35 U.S.C. § 103:

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 2220 USPQ 303 (Fed. Cir. 1983)."

In addition, MPEP § 2143.01 states that:

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)."

Applicant respectfully submits that Yamada's disclosure of allowing the photographic information to be used as supplementary information teaches away from the Examiner's proposed modification (i.e., teaches away from capturing supplementary information by searching a database). Accordingly, the Examiner's proposed modification would inevitably change the principle of operation of Yamada. Thus, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness as to claims 10 and 24.

Applicant respectfully submits that claims 10 and 24 are allowable at least for the reasons set forth above. Accordingly, Applicant submits that claims 11 and 25 are allowable at least by virtue of their dependency on claims 10 and 24.

**II. Claims 31-34, 38, 40.**

Claims 31-33 and 38-40 stand rejected under 35 USC § 103(a) as being unpatentable over the admitted prior art in view of Kinjo.

Claim 34 stands rejected under 35 USC § 103(a) as being unpatentable over the admitted prior art in view of Kinjo, and further in view of Japanese Patent Publication No. 8-240854 to Fukutani et al. (hereinafter "Fukutani").

M.P.E.P. § 2143.03 sets forth the following requirements for a proper rejection under 35 U.S.C. § 103:

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)."

As amended, independent claim 31 recites: 1) "reading photographing information in association with the images of respective photographing frames"; 2) "determining similarity between the respective photographing frames based on the read photographing information"; and 3) "the photographing information is at least one of a photographing location and the photographing direction of the camera." Independent claims 32 and 40, as amended, each recites similar features. Applicant respectfully submits that the Examiner has failed to provide a

teaching or suggestion of these features in the admitted prior art or Kinjo.

In pages 9-10 of the Office Action, the Examiner asserts that these three features are taught by Kinjo in column 4, line 59 - column 5, line 63. Applicant respectfully disagrees.

However, what is disclosed in column 5, lines 5-20 in Kinjo is that "the photographing conditions, such as the luminance value obtained when different areas on a subject are measured to determine an exposure, magnification, distance to a subject, subject in-focus position, stop, and shutter speed, are substantially equal when the photographing times are close to each other and even if the compositions of the scene are slightly different from each other." Hence, column 5, lines 21-25 describes that "it can be decided that the images photographed under the equal or similar photographing conditions, i.e., the images of which the photographing information representative of the photographing conditions are equal or similar are formed by photographing similar scenes." ✓

In other words, the cited portions of Kinjo indicate that "photographing condition" is a "photographing condition" at the time of photographing by a camera. More particularly, it is an operational condition of a camera when the camera is in operation to photograph a subject or a result of such operation.

In fact, Kinjo in its claims and other portions that "photographing information" is "photographic information representative of the photographing conditions." Accordingly, the values of the "photographing information" in the cited portions of Kinjo will vary "even if the compositions of the scene are slightly different from each other."

Kinjo will only determine that a scene is similar to other scenes when the values of this "photographic information" barely change. In other words, Kinjo discloses that this information is limited to information whose values do not significantly change among similar scenes.

Conversely, claims 31, 32, and 40 each requires determining similarity between respective photographing frames photographing information comprising least one of photographing location and photographing direction of the camera. As described in the paragraph bridging pages 10 and 12 of the present specification, "landscape images in which Mt. Fuji having different compositions are photographed from different locations" have significantly varied "photographing location" and "photographing direction of the camera"; however, these images need to be determined as similar frames in order to be subjected to the image processing to equalize the color density of "Mt. Fuji."

Accordingly, the "photographing information" in the cited portions of Kinjo excludes information such as photographing location and photographing direction of the camera.

Since the cited portions of Kinjo fail to disclose such types of photographic information, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness as to independent claims 31, 32, and 40. Accordingly, Applicant submits that claims 31, 32, and 40, and dependent claims 33 and 38, are allowable at least for this reason.

As to claim 34, Applicant respectfully submits that the Examiner has failed to point out any teaching in Fukutani that remedies the deficiencies of the admitted prior art and Kinjo. Accordingly, Applicant respectfully submits that claim 34 is allowable at least by virtue of its dependency on claim 32.

### **III. Claims 41-45, 59-64.**

Claims 41-45, 60, 61, and 63 stand rejected under 35 USC § 102(a) as being anticipated by the alleged admitted prior art.

Claim 43 stands alternatively rejected under 35 USC § 103(a) as being unpatentable over additional alleged admitted prior art.

Claims 59 and 64 stand rejected under 35 USC § 102(a) as being anticipated by U.S. Patent No. 5,710,954 to Inoue (hereinafter "Inoue").

Claim 62 stands rejected under 35 USC § 103(a) as being unpatentable over the admitted prior art in view of Inoue.

Initially, Applicant points out that claims 59-64 have been canceled above. Accordingly, Applicant respectfully submits that prior art rejections as to claims 59-64 are now moot.

#### Admitted Conventional Art and Inoue

The admitted conventional art cited by the examiner relates to the APS techniques on page 12, line 15 to page 13, line 6 in the specification of the present application, merely discloses a camera with APS system that uses APS film. Inoue discloses the conventional APS technique similarly to that mentioned above and further discloses the technique to reproduce supplementary information together with photographed image on a monitor to be confirmed by a user.

According to the APS techniques taught by the admitted conventional art and Inoue, supplementary information is generated inside of the camera at the time of photographing, and recorded to the magnetic recording layer of the APS film immediately after photographing.

Independent Claim 41 Not Taught Nor Suggested

Independent claim 41, as amended, now recites a print method that records supplementary information to a supplementary information recording region before a recording medium is mounted on the camera. Thus, claim 41 requires the recording of supplementary information from outside the camera to a recording medium before photographing occurs. The APS technique disclosed in the admitted conventional art does not disclose this feature. Furthermore, Inoue similarly discloses the use of APS, and thus fails to remedy the deficiencies of the admitted conventional art as to claim 41.

Accordingly Applicant respectfully submits that claim 41 is allowable at least for the reasons set forth above. Further, Applicant submits that claims 42-45 are allowable by virtue of their dependency on claim 41.

Furthermore, as to the Examiner's § 103 rejection of claim 43, Applicant respectfully submits that the teachings of the admitted conventional art in page 14, lines 1-7 of the specification fail to provide a teaching or suggestion that remedies the above deficiencies of the admitted conventional art applied against claim 41.

Applicant further submits that new claims 68-79 incorporate the same or similar features as those discussed



above in connection with claim 41, and are therefore similarly allowable.

#### **IV. Claims 46-48.**

As discussed above, claims 46-48 have been allowed by the Examiner. Claim 46 has been amended above. Applicant respectfully submits that these amendments do not broaden the scope of the claims. Thus, Applicant respectfully submits that claims 46-48 are still in condition for allowance as indicated by the Examiner.

#### **No Prosecution History Estoppel**

Claims 10, 12, 24, and 26 are hereby presented in independent form. No prosecution history estoppel would apply to the interpretation of the limitations set forth in claims 10, 12, 24, and 26 and the claims that depend therefrom in view of the fact that this subject matter has been continuously presented since the original filing date of the present application.

#### **Conclusion**

Since the remaining patents cited by the Examiner have not been utilized to reject the claims, but to merely show the state of the art, no comment need be made with respect thereto.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of (703) 205-8000, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to the provisions of 37 CFR 1.17 and 1.136(a), Applicant respectfully petitions for a three (3) month extension of time for filing a response in connection with the present application. The required fee of \$950.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By



Michael R. Cammarata, #39,491

  
MRC/JWR

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000